



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,329	09/18/2003	Thomas Richard Tepe	A01446	6250
21898	7590	09/15/2005	EXAMINER	
ROHM AND HAAS COMPANY PATENT DEPARTMENT 100 INDEPENDENCE MALL WEST PHILADELPHIA, PA 19106-2399			RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

h

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/665,329	Applicant(s) TEPE, THOMAS RICHARD	
	Examiner Vickey Ronesi	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-8 and 11-18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

h

Attachment to Advisory Action

Applicants' amendment filed 9/2/2005 has been considered however, the amendment has not been entered given that it raises other new issues that would require further consideration and/or search.

With respect to other new issues, claim 1 has been amended to recite that the copolymer contains 40-75 wt % C₂-C₄ alkyl (meth)acrylate residue. It is the examiner's position that this is a new issue for two reasons. First, the limitation of 40-75 wt % was before presented with C₂-C₃ alkyl (meth)acrylate residues (and not C₄ alkyl (meth)acrylate residues). Second, the limitation of 40-75 wt % was before presented with a copolymer that included 5-15 wt % lipophilically modified (meth)acrylate residues. Neither of these limitations is also presented in claim 1. Thus, a claim with a recitation of 40-75 wt % C₂-C₄ alkyl (meth)acrylate residue without the aforementioned limitations is a new issues and therefore would require further consideration and/or search.

Since amendments are not entered in part, the declaration filed 9/2/2005 signed by Fanwen Zeng has not been entered. For applicant's convenience, should the first part of the amendment (i.e., the amendment to the claims) have been entered, the declaration would also have been entered. Even if so, the declaration is considered insufficient to overcome the outstanding 35 USC 112(1), written description rejection since, according to the examiner's calculations as shown in the Tables below, the amounts of comonomer in grams and the amounts in weight % in the declaration are incongruous.

Art Unit: 1714

Sample ID 38100

	Data from Declaration filed 9/2/2005		Examiner's Calculation
	Amount (g)	Amount (wt %)	Amount (wt %)
EA	300.0	60.0	59.0
Lipo 1	71.4	10.0	14.0
MAA	35.7	10.0	7.0
AA	100.0	20.0	19.7
DAP	1.00	0.20	0.20
n-DDM	0.50	0.10	0.10

Sample ID 3896

	Data from Declaration filed 9/2/2005		Examiner's Calculation
	Amount (g)	Amount (wt %)	Amount (wt %)
EA	300.0	60.0	59.1
Lipo 1	71.4	10.0	14.1
MAA	35.7	10.0	7.0
AA	100.0	20.0	19.7
DAP	0.50	0.1	0.1

Sample ID 3824

	Data from Declaration filed 9/2/2005		Examiner's Calculation
	Amount (g)	Amount (wt %)	Amount (wt %)
EA	297.5	42.0	40.9
Lipo 1	182.1	18.0	25.0
MAA	246.9	40.0	33.9
DAP	1.42	0.20	0.20
n-DDM	0.00	0.00	0.00

In light of the above, it is clear that applicant's declaration would have been insufficient to overcome the outstanding 35 USC 112(1), written description rejection.

9/13/2005

vr

vr

Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700